

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:
Terrence M. Doeberl, et al.

) Attorney Docket No.: F-682-O1
) Customer No.: 00919
) Examiner: ADE, Oger Garcia
) Group Art Unit: 3687
)
) Date: November 28, 2008

Serial No.: 10/709,230
Filed: April 22, 2004
Confirmation # 3229

Title: **SYSTEM AND METHOD FOR MANAGING BUSINESS MACHINE ASSETS**

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANTS' CORRECTED BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 41.31 et seq. from the final rejection of claims 1-20 of the above-identified application mailed May 20, 2008. This corrected Brief is in response to the Notice of Non-Compliant Appeal Brief transmitted in this case on October 28, 2008. Accordingly, this brief is timely filed. **No fee is believed due.** The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. **16-1885**.

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

Commonly-owned, co-pending application 10/249,613 names the same inventors as the present application, describes certain similar subject matter and is also being appealed. Commonly-owned, co-pending application 10/249,615 names the same inventors as the present application, describes certain similar subject matter and is also being appealed. There are no other appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-20 are in the case and under final rejection of the Examiner.

Claims 1-20 are in the case and stand provisionally rejected on the ground of nonstatutory obviousness-type double-patenting over claims 1-5 and 11-24 of copending Application No. 10/249,615.

Claims 1-20 are in the case and stand finally rejected under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent 6,952,680 to Melby, et al. ("Melby '680") in view of U.S. Patent 7,315,887 B1 to Liang, et al ("Liang '887").

Appellants hereby appeal the final rejection of claims 1-20.

IV. Status of Amendments

No Amendments have been filed subsequently to the Final Office Action of May 20, 2008 ("Final Rejection"). Therefore, the claims set forth in Appendix A to this brief are those as pending prior to the Final Rejection.

V. Summary of Claimed Subject Matter

Appellants' invention as presently claimed relates generally to a new and useful method for managing assets such as managing outsourced business machine client fleets on either an on-site, decentralized basis or on centralized, cross-client bases. The present application describes systems and methods for managing the physical placement of such assets. A comprehensive system includes a system for asset management supporting equipment replacement and movement using equipment utilization analysis, equipment comparison analysis and optimization analysis. See Abstract, Specification at ¶¶ 0008-9 and FIG. 1.

Many companies purchase business machines such as output devices including printers in a haphazard fashion in which users request printers from the Information Technology (IT) department. Such strategies are based upon individual need at a point in time and may not consider changes to those needs over time and when making future purchase decisions. In such environments, half of the output devices may be underutilized and a quarter may be over-utilized. The systems described herein may be utilized to right-size a fleet.

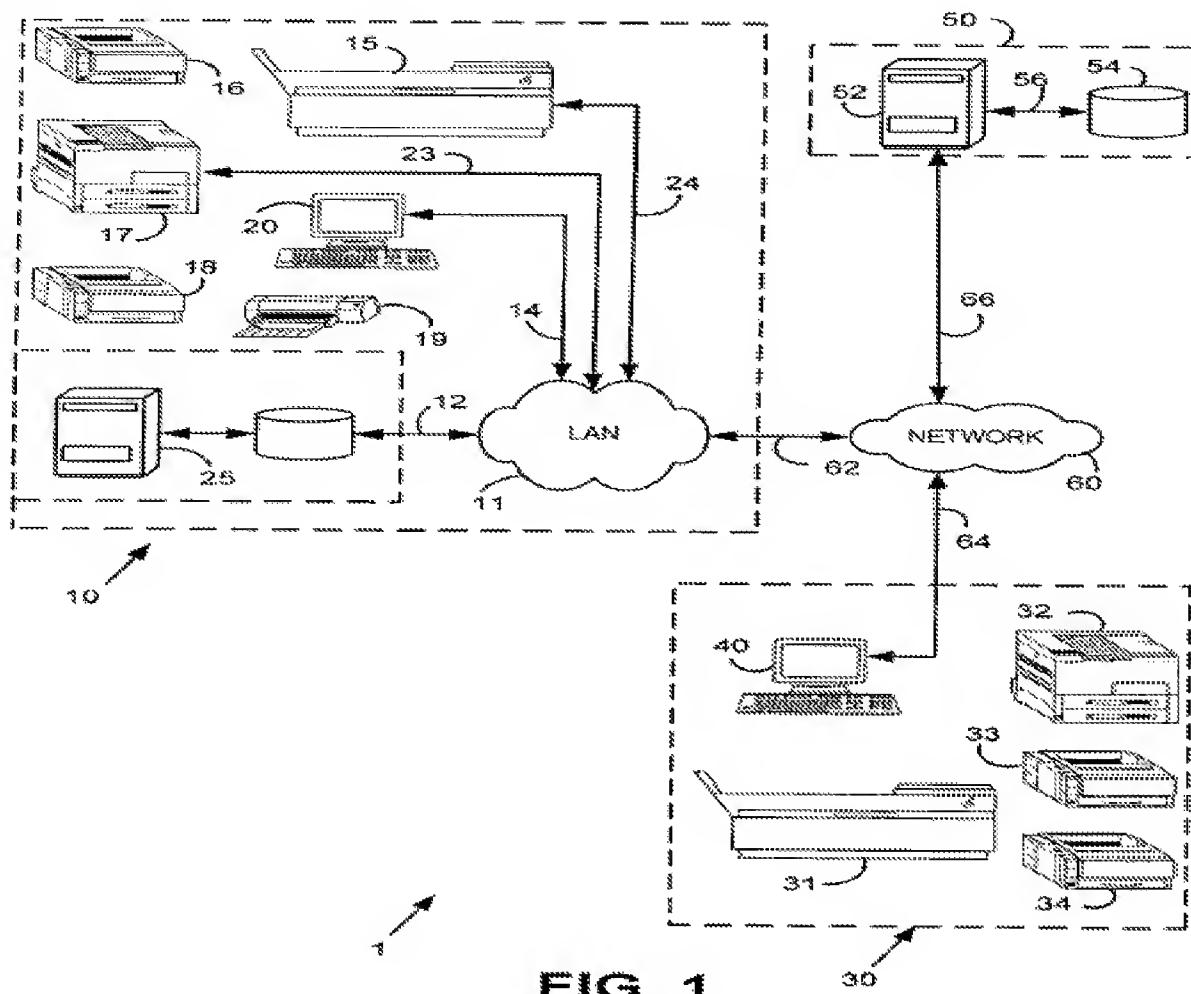
With reference to FIGs. 1 and 11 below (formal versions), standalone copier 31 may be considered for replacement at a point in time. See FIGs. 1 and 11 and Specification at ¶¶ 0086-95, 0125-27. A method to determine and optimize output device placement within a localized site, campus, or enterprise environment is described. The Asset Management system maintains a database of the specific output devices utilized by the customer, along with various financial models and contracts used to calculate cost of ownership of the device. The system maintains output device life-cycle information, including usage statistics, downtime, device speed (pages per minute), etc. The system tracks historical device mean and peak usages. The system provides a method to maintain physical information including hours of operation, device users, etc. The system provides a method to maintain the customer's departmental/organizational structure and internal allocation and chargeback methods. The system uses this information to create a hierarchical view of the customer's physical and departmental organization at the site, campus, and enterprise levels.

By combining the customer's historical usage statistics and life cycle information with the total cost of ownership of the output devices, the system determines the optimum physical placement of output devices within the customer's sites, campuses, and enterprise. The system combines the optimum physical placement of output devices with the customer's departmental and/or organizational usage statistics to further refine the placement of the devices relative to the customer's internal allocation and charge-back mechanisms.

Accordingly, the system provides for a reduction in output devices within the customer's sites, campuses, and enterprise, thereby reducing cost. Furthermore, the system allows for identification of peak utilization physical areas and departments and/or organizations, and thereby allows optimization of the placement of high-end, high-performance devices. Additionally, the system provides for ensuring the optimum utilization of high-cost output devices.

Additionally, a method for determining optimum output device replacement within a localized site, campus, or enterprise environment. The Asset Management software system maintains a database of the specific output devices utilized by the customer. The system provides the end-user with a GUI and method to define customer-specific financial charge/cost models that will be applied to a specific or group of devices.

The system provides a method to assign primary replacement models for output devices. The primary replacement model can have alternate billing methods applied to it. The system provides a series or reports that compares the trend and costs associated with the existing output device to the primary replacement. The system provides for identification, trending, and prediction of alternate output devices or cost models. It provides for efficient management of existing device contracts. It also provides for identification of under-utilized or over-charged devices, and therefore candidates for replacement. Additionally, the Asset Manager System provides for accounting for the movement of an asset physically and/or financially. In at least one embodiment, an asset is assigned a location including a postal Zip code.



Independent claim 1 is shown with illustrative annotated reference to the specification, reference numerals and figures that may illustrate certain elements:

1. A method for providing asset physical placement analysis for an organization comprising (FIGs. 1, 11, ¶¶ 0086-95, 0125-27):
 - obtaining historical asset usage data over a plurality of periods for a plurality of assets (10, 30, FIGs. 1, 11);
 - obtaining asset physical placement data associated with the plurality of assets over the plurality of periods (10, 30, FIGs. 1, 11);
 - determining suggested alternate asset physical placement data using the asset usage data and the asset physical placement data (10, 30, FIGs. 1, 11); and
 - providing the suggested alternate asset physical placement data (10, 30, FIGs. 1, 11).

Referring to FIG. 11, an example for evaluating replacement candidates and scenarios is shown. The report snippet shown in FIG. 11 is a result of running the Assets Compared to Preferred Replacement report. The system compares Assets to Preferred Replacements. The report provides a list of all parent assets and their respective volumes for a specified period of time. The base cost and click cost for the asset are compared to the costs of the preferred replacement model, and potential savings are noted. The alternate model selection indications include all possible indications in series. See Fig. 11, Specification at ¶¶ 0125-27.

Volume	Brand	Model	Current Model			Preferred Replacement Model			Potential Savings		
			BaseCost	ClickCost	Target Vol	Brand	Model	BaseCost	ClickCost		
34,631	Canon	6050	1,500.00	\$16.77	99,000	Canon	6051	2,000.00	\$6.27	99,000	(58.50)
NOTE: AssetTag #116802 uses CPC: 0.01500 and Preferred Replacement entitles Default Volume Band: Digital C1221E											
37,352	Canon	6050	1,500.00	\$66.78	99,000	Canon	6051	2,000.00	\$7.33	99,000	(42.10)
NOTE: AssetTag #116803 uses CPC: 0.01800 and Preferred Replacement entitles Default Volume Band: Digital C1221E											
49,168	Canon	6050	1,500.00	737.34	99,000	Canon	6051	2,000.00	149.46	99,000	22.34
NOTE: AssetTag #116804 uses CPC: 0.01500 and Preferred Replacement entitles Default Volume Band: Digital C1221E											
62,893	Canon	6050	1,500.00	944.84	99,000	Canon	6051	2,000.00	208.33	99,000	298.61
NOTE: AssetTag #116805 uses CPC: 0.01500 and Preferred Replacement entitles Default Volume Band: Digital C1221E											
36,504	Canon	6050	1,500.00	547.58	99,000	Canon	6051	2,000.00	106.33	99,000	(57.33)
NOTE: AssetTag #116807 uses CPC: 0.01500 and Preferred Replacement entitles Default Volume Band: Digital C1221E											
41,874	Canon	6050	1,500.00	678.11	99,000	Canon	6051	2,000.00	126.17	99,000	2.84
NOTE: AssetTag #116808 uses CPC: 0.01500 and Preferred Replacement entitles Default Volume Band: Digital C1221E											
39,926	Canon	6050	1,500.00	808.04	99,000	Canon	6051	2,000.00	116.46	99,000	(17.56)
NOTE: AssetTag #116810 uses CPC: 0.01500 and Preferred Replacement entitles Default Volume Band: Digital C1221E											
46,448	Canon	6050	1,500.00	881.59	99,000	Canon	6051	2,000.00	127.36	99,000	64.33
NOTE: AssetTag #116812 uses CPC: 0.01500 and Preferred Replacement entitles Default Volume Band: Digital C1221E											
41,804	Canon	6050	1,500.00	627.08	99,000	Canon	6051	2,000.00	122.46	99,000	4.61
NOTE: AssetTag #116817 uses CPC: 0.01500 and Preferred Replacement entitles Default Volume Band: Digital C1221E											

FIG. 11

Independent claim 11 is shown with illustrative annotated reference to the specification, reference numerals and figures that may illustrate certain elements:

11. A method for providing physical asset placement analysis for an organization comprising (FIGs. 1, 11, ¶¶ 0086-95, 0125-27):
obtaining historical asset usage data over a plurality of periods for a plurality of assets (10, 30, FIGs. 1, 11);
obtaining physical asset placement data specifying a plurality of physical locations each associated with the plurality of assets (10, 30, FIGs. 1, 11);
determining peak usage for at least one of the physical locations using the historical asset usage data and the physical asset placement data (10, 30, FIGs. 1, 11); and
suggesting at least one replacement asset for the at least one physical location (10, 30, FIGs. 1, 11).

Independent claim 17 is shown with illustrative annotated reference to the specification, reference numerals and figures that may illustrate certain elements:

17. A method for providing physical asset placement analysis for an organization comprising (FIGs. 1, 11, ¶¶ 0086-95, 0125-27):
obtaining historical asset usage data over a plurality of periods for a plurality of assets (10, 30, FIGs. 1, 11);
obtaining physical asset placement data specifying a plurality of physical locations each associated with the plurality of assets (10, 30, FIGs. 1, 11);
obtaining alternate asset data including replacement asset data associated with each of the plurality of assets (10, 30, FIGs. 1, 11);
suggesting at least one replacement asset for at least one of the plurality of assets using the historical asset usage data, the physical asset placement data and the alternate asset data (10, 30, FIGs. 1, 11).

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Grounds of Rejection to Be Reviewed on Appeal

- A. Whether claims 1-20 are patentable under the obviousness-type double patenting doctrine.
- B. Whether claims 1-20 are patentable under 35 U.S.C. §103(a).

VII. Argument

As discussed in detail below, Appellant respectfully submits that the final rejection of claims 1-20 does not meet the threshold burden of presenting a prima facie case of unpatentability. Accordingly, Appellant is entitled to grant of those claims. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A Claims 1-20 are not Unpatentable due to double patenting

Claims 1-20 are in the case and stand provisionally rejected on the ground of nonstatutory obviousness-type double-patenting over claims 1-5 and 11-24 of copending Application No. 10/249,615.

Appellants traverse and respectfully submit that since Application No. 10/249,615 is being appealed and not issued, that the claims of the present application are not invalid on the ground of nonstatutory obviousness-type double-patenting. Moreover, the provisional rejection did not compare the present claims to those in Application No. 10/249,615. Accordingly, the rejection should be reversed.

B Claims 1-20 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 1-20 are in the case and stand finally rejected under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent 6,952,680 to Melby, et al. ("Melby '680") in view of U.S. Patent 7,315,887 B1 to Liang, et al ("Liang '887").

Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below.

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S.Ct. 1727, 1735 (2007) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting Kahn, 441 F.3d at 988)). See also, *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1357 (Fed. Cir. 2007) (To avoid improper use of hindsight, the Examiner must articulate “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. (quoting *KSR*, 127 S. Ct. at 1731)).

See also, *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006)(Most inventions arise from a combination of old elements and each element may often be found in the prior art. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole).

Initially, in section 5 of the Final Office Action, the Examiner uses impermissible hindsight as an alleged basis for the combination of Melby '680 and Liang '887. Here, Liang '887 is a mere inventory control system and does not teach or describe deciding where to place assets. The Examiner cites only to the abstract and FIG. 1, elements 120 and 155 of Liang '887. As the Background and Summary of Invention clearly state, Liang '887 merely describes combining two known inventory systems in order to provide inventory of both on-line and off-line communications cards. See Liang '887, Col. 1,

lines 13-56. Similarly, Melby '680 does not teach or fairly suggest a physical placement analysis of any kind. Moreover, the combination, even if proper, would not teach or fairly describe each element of the claims as currently presented. Accordingly, the rejection should be reversed.

Independent Claim 1 recites:

1. A method for providing asset physical placement analysis for an organization comprising:
 - obtaining historical asset usage data over a plurality of periods for a plurality of assets;
 - obtaining asset physical placement data associated with the plurality of assets over the plurality of periods;
 - determining suggested alternate asset physical placement data using the asset usage data and the asset physical placement data; and
 - providing the suggested alternate asset physical placement data.

(emphasis added). The Examiner admits that Melby '680 does not teach or describe any physical placement analysis and Liang '887 does not cure that shortcoming in the art. Melby '680 does not teach, describe or fairly suggest a replacement asset analysis, but rather apparently describes efficient maintenance of an installed base of assets. Melby '680, discusses a system for tracking when maintenance operations should be performed on an existing fleet of installed assets. For example, the system in Melby '680 may track usage to determine when a preventative maintenance operation should be scheduled. However, there is no disclosure in Melby '680 of a replacement asset analysis and no suggestion of modeling a replacement asset costs based upon usage data collected for the installed asset. Furthermore, Melby '680 does not describe any physical placement analysis. Similarly, Melby '680 does not teach or suggest taking data historical usage data over a plurality of periods.

Appellants respectfully submit that the Examiner has failed to establish that Melby '680 in combination with Liang '887 render the claims obvious and accordingly respectfully submit that the rejection should be reversed.

Dependent claims 2-10 and 16 are patentable over the cited reference for at least the same reasons described above with reference to the associated independent claim and any intervening claims.

Similarly, with reference to claims 2 and 6, Melby '680 does not teach, describe or fairly suggest determining a suggested alternate asset and does not describe using a best fit algorithm.

2. The method of claim 1, further comprising:
 - determining suggested alternate asset data; and
 - providing the suggested alternate asset data.

Furthermore, regarding claims 3, Melby '680 does not teach, describe or fairly suggest second physical placement data.

3. The method of claim 2, further comprising:
 - determining suggested second physical placement data for the suggested alternate asset data; and
 - providing the suggested second physical placement data..

Moreover, with reference to claim 5, Melby '680 does not teach, describe or fairly suggest any peak time analysis.

5. The method of claim 1, wherein:
 - the assets usage data is categorized into peak and off-peak categories.

Furthermore, regarding claims 7-8 and 9-10, Melby '680 does not teach, describe or fairly suggest department physical placement determination s or hierachal physical placement determinations.

Independent Claim 11 recites:

11. A method for providing physical asset placement analysis for an organization comprising:
 - obtaining historical asset usage data over a plurality of periods for a plurality of assets;

obtaining physical asset placement data specifying a plurality of physical locations each associated with the plurality of assets;
determining peak usage for at least one of the physical locations using the historical asset usage data and the physical asset placement data; and
suggesting at least one replacement asset for the at least one physical location.

(emphasis added). Initially, Appellants respectfully submit that the references are not properly combined for at least the reasons described above. Furthermore, the Examiner does not suggest that the combination of Melby '680 and Liang '887 teach peak usage determinations.

Dependent claims 12-15 and 20 are patentable over the cited reference for at least the same reasons described above with reference to the associated independent claim and any intervening claims.

Independent Claim 17 recites:

17. A method for providing physical asset placement analysis for an organization comprising:
obtaining historical asset usage data over a plurality of periods for a plurality of assets;
obtaining physical asset placement data specifying a plurality of physical locations each associated with the plurality of assets;
obtaining alternate asset data including replacement asset data associated with each of the plurality of assets;
suggesting at least one replacement asset for at least one of the plurality of assets using the historical asset usage data, the physical asset placement data and the alternate asset data.

(emphasis added). Initially, Appellants respectfully submit that the references are not properly combined for at least the reasons described above. Furthermore, the Examiner apparently does not suggest that the combination of Melby '680 and Liang '887 teach any replacement asset analysis.

Dependent claims 18-19 are patentable over the cited reference for at least the same reasons described above with reference to the associated independent claim and any intervening claims.

Thus, the Examiner has not established a prima facie anticipation rejection. Accordingly, Appellants respectfully submit that the rejection is clearly in error and should be reversed.

IX. Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-20 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,

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VIII – CLAIMS APPENDIX
APPENDIX A

1. A method for providing asset physical placement analysis for an organization comprising:

obtaining historical asset usage data over a plurality of periods for a plurality of assets;

obtaining asset physical placement data associated with the plurality of assets over the plurality of periods;

determining suggested alternate asset physical placement data using the asset usage data and the asset physical placement data; and

providing the suggested alternate asset physical placement data.

2. The method of claim 1, further comprising:

determining suggested alternate asset data; and

providing the suggested alternate asset data.

3. The method of claim 2, further comprising:

determining suggested second physical placement data for the suggested alternate asset data; and

providing the suggested second physical placement data.

4. The method of claim 1, wherein:

the assets include copy machines.

5. The method of claim 1, wherein:

the assets usage data is categorized into peak and off-peak categories.

6. The method of claim 1, wherein:

the suggested alternate asset physical placement data is determined using a best fit algorithm.

7. The method of claim 1, further comprising:

obtaining organization department physical location data;

obtaining historical asset usage data over a plurality of periods for a plurality of assets, wherein the historical usage data is associated with the organization physical location data;

determining suggested alternate asset physical placement data using the asset usage data, the asset physical placement data and the organization department physical location data;

providing asset usage data organized by department physical location;
and

providing the suggested alternate asset physical placement data.

8. The method of claim 7, wherein:

the suggested alternate asset physical placement data is determined using a best fit algorithm.

9. The method of claim 1, further comprising:

determining hierachal usage data using the asset physical placement data organized in a hierarchy including room number data; and
providing the hierachal usage data.

10. The method of claim 7, further comprising:

determining hierachal usage data using the organization department physical location data organized in a hierarchy including room number data; and
providing the hierachal usage data.

11. A method for providing physical asset placement analysis for an organization comprising:

obtaining historical asset usage data over a plurality of periods for a plurality of assets;

obtaining physical asset placement data specifying a plurality of physical locations each associated with the plurality of assets;

determining peak usage for at least one of the physical locations using the historical asset usage data and the physical asset placement data; and

suggesting at least one replacement asset for the at least one physical location.

12. The method of claim 11, further comprising:

obtaining department data for a plurality of departments of the organization associated with the physical asset placement data specifying a plurality of physical locations each associated with the plurality of assets;

determining peak usage for at least one of the departments using the historical asset usage data, the department data and the physical asset placement data; and

suggesting at least one replacement asset for the at least one department.

13. The method of claim 11, wherein:

the assets include copy machines.

14. The method of claim 11, wherein:

the assets usage data is categorized into peak and off-peak categories.

15. The method of claim 11, wherein:

the suggested alternate physical asset placement data is determined using a best fit algorithm.

16. The method of claim 1, further comprising:

updating the asset physical placement data using the suggested alternate asset physical placement data.

17. A method for providing physical asset placement analysis for an organization comprising:

obtaining historical asset usage data over a plurality of periods for a plurality of assets;

obtaining physical asset placement data specifying a plurality of physical locations each associated with the plurality of assets;

obtaining alternate asset data including replacement asset data associated with each of the plurality of assets;

suggesting at least one replacement asset for at least one of the plurality of assets using the historical asset usage data, the physical asset placement data and the alternate asset data.

18. The method of claim 17, wherein:

the assets include copy machines.

19. The method of claim 17, wherein:

the physical asset placement data comprises hierachal organization data.

20. The method of claim 11, wherein:

the suggested alternate physical asset placement data is determined using a best fit algorithm.

Appendix IX – Evidence Appendix

None

Appendix X – Related Proceedings Appendix

None